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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 09/239,016 | 01/29/1999 | MASAMICHI ITO | 35.C13284 | 5590 |

5514 7590 10/10/2002

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EXAMINER

POON, KING Y

| ART UNIT | PAPER NUMBER |
|----------|--------------|
|----------|--------------|

2624

DATE MAILED: 10/10/2002

7

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/239,016

Applicant(s)

MASAMICHI ITO ET AL.

Examiner

King Y. Poon

Art Unit

2624

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-12 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-12 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 29 January 1999 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☒ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) ____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

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DETAILED ACTION

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

2. Claims 1-12 are rejected under 35 U.S.C. 102(e) as being anticipated by Boetje et al (US 6,289,167).

Regarding claim 1: Boetje teaches an image recording and reproducing device (fig. 2) comprising: record processing means (DVCR, column 5, lines 20-25) for recording image data (audio/video data, fig. 1) on a first recording area of a recording medium (108, column 3, lines 55-65) and recording specific information (computer generated scoreboard, column 9, lines 1-20) on a second recording area (data base 106, fig. 1, column 8, lines 63-64, column 11, lines 8-15) of the recording medium; (fig. 1) reproduction processing means (DVCR, column 9, lines 10-20) for reproducing the first and second recording areas; (DVCR is for recording data onto recording area of a tape, column 2, lines 35-40) and means (server, column 9, lines 45-65) for converting the reproduced specific information to electric information, (server generated scoreboard, column 9, lines 54-55, a server is a computer, and a computer generates electric signals/ voltage, current)

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which is difficult to recognize, (computer generated electric signal is difficult recognized without an electric sensor) so that the electric information (server generated scoreboard, column 9, lines 54-55) is selectively combined (if desired, column 9, lines 50-55, concatenated, column 9, lines 50-60) with the image data (video clips, column 9, lines 54-55).

Regarding claim 2: Boetje teaches multiplexing means (the function of the server that is performing the intercutting, column 9, lines 50-55, column 8, lines 1-15) for multiplexing the converted electric information, (scoreboard, column 9, lines 54-55) which is difficult to recognize, (computer generated electric signal is difficult recognized without an electric sensor) and the reproduced image data, (video clips, column 9, lines 54-55) to output; and selecting means (assembly/edit process of the server, column 9, lines 45-50) for selecting the multiplexed data obtained from the multiplexing means or the reproduced image data to output. (Column 9, lines 45-65)

Regarding claim 3: Boetje teaches generating means (computer, column 9, lines 9-11) for generating the specific information (scoreboard, column 9, lines 54-55).

Regarding claim 4: Boetje teaches wherein the first recording area is provided on a first recording medium (videotapes, column 9, lines 30-35) and the second recording area is provided on a second recording medium. (Tapes, column 11, lines 9-15)

Regarding claims 5-8: Claims 5-8 are method steps for the apparatus discussed in claims 1-4. Please see claims 1-4.

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Regarding claims 9-12: Boetje teaches a memory medium (video server, column 6, lines 55-60) readable with computer (column 6, line 64) used for carrying out the processing by the apparatus discussed in claims 1-4. Please see claims 1-4.

Conclusion

3. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Inoue et al. (US 6,226,449) teaches apparatus for recording and reproducing image data on two different area of a recording medium.

Ryan et al. (US 6,374,036) teaches video recording using watermark.

Moskowitz et al. (US 5,889,868) teaches using watermarking in digital data.

4. Any inquiry concerning this communication or earlier communications from the examiner should be directed to King Y. Poon whose telephone number is (703) 305-0892 or to Supervisor Mr. David Moore whose phone number is (703) 308-7452.

September 30, 2002

A handwritten signature in cursive script, appearing to read "Gabriel Garcia". The signature is written in dark ink and is positioned to the right of the date.